

In re Application of:
RALPH H. CASTRO et al.
Application No.: 10/627,512
Filed: July 25, 2003
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PATENT
Docket No.: K35A1302

REMARKS

In the Office Action in the parent application, claims 1-6, 9-14 and 17-22 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent No. 6,018,789 to Sokolov et al. patent (the "Sokolov '789" patent) in view of U.S. Patent No. 5,481,694 to Chao et al.

Applicants respectfully traverse each of the rejections and respectfully request reconsideration of this application in light of the following remarks.

The rejection of claims 1-6, 9-14 and 17-22 as allegedly unpatentable over the Sokolov '789 patent in view of the Chao et al. patent is respectfully traversed.

Applicants assert that the Sokolov '789 patent is not an appropriate reference under 35 U.S.C. 102(e) and seek disqualification of the Sokolov '789 patent as prior art under 35 U.S.C. 102(e) against the pending claims (see 35 U.S.C. §103(c)). In this regard:

U.S. Patent No. 6,018,789 (Sokolov et al.) was owned by Western Digital Corporation, and the inventors of the invention of parent application No. 09/552,399 and the above-identified continuation application No. 10/627,512, which is a continuation of the parent application, were under an obligation to assign the invention of the parent application No. 09/552,399 and the continuation application No. 10/627,512 to Western Digital Corporation, at the time the invention of parent application No. 09/552,399 and the continuation application No. 10/627,512 was made.

According to MPEP §706.02(1)(2), the above statement is sufficient to disqualify the Sokolov '789 patent. As additional evidence of common ownership, Applicants provide the following data. For U.S. Patent No. 6,018,789, an assignment from inventors, Daniel John Sokolov and Jeffrey L. Williams, to Western Digital Corporation is recorded beginning at Reel 8898, Frame 0004. The recordation date is November 24, 1997. For parent application number 09/552,399, assignments from inventors, Tsun Y. Ng, Ralph H. Castro, and Virgil V. Wilkins, to Western Digital Corporation is recorded beginning at Reel 010738, Frame 0639.

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Applicants assert that the Effective Date of the the Sokolov '789 patent as prior art (either as a patent or a printed publication) under 35 U.S.C. § 102(a) against the above-identified continuation application is the patent's issue date of January 25, 2000. The attached Declarations by the inventors and the referenced exhibits show that the inventions defined by claims 1-6, 9-14 and 17-22 were reduced to practice in the United States before the Effective Date (January 25, 2000) of the Sokolov '789 patent under 35 U.S.C. § 102(a). More specifically, the attached new Declarations establish reduction to practice of the each feature recited in claims 1-6, 9-14 and 17-22 before the Effective Date of the Sokolov '789 patent by means of a "Rebel" disk drive, and the exhibits corroborate the existence of the Rebel disk drive before the Effective Date of the Sokolov '789 patent. Applicants note that an "accompanying exhibit need not support all claimed limitations, provided that any missing limitation is supported by the declaration itself." See, MPEP 715.07. Applicants assert that the attached inventor Declarations submitted in accordance with 37 C.F.R. 1.131 shows invention of the claimed subject matter before the Effective Date of the Sokolov '789 patent under 35 U.S.C. § 102(a), and accordingly, swear behind the Effective Date of the Sokolov '789 patent.

Applicants respectfully assert that the rejections of claims 1-6, 9-14 and 17-22 under 35 U.S.C. § 103(a) are now improper in light of the disqualification of the Sokolov '789 patent as prior art under 35 U.S.C. § 102(e) and the removal of the Sokolov '789 patent as prior art under 35 U.S.C. § 102(a). Accordingly, Applicants request allowance of claims 1-6, 9-14 and 17-22.

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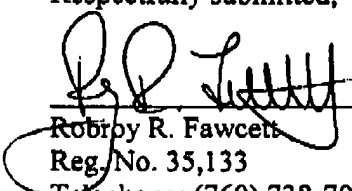
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CONCLUSION

In view of the above amendments and remarks, consideration and prompt evaluation of all pending claims are respectfully requested. If any questions or issues remain, the Examiner is invited to contact the undersigned at the telephone number set forth below so that prosecution of this application can proceed in an expeditious fashion.

Respectfully submitted,

Date: October 22, 2003


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